

Remarks:

Claims 1-42 are pending.

Present claims 2-5, 14-20, 22-25, and 27-36 stand withdrawn from consideration pursuant to restriction.

Claims 1, 6-13, 21, 26, 37-42 were rejected under 35 USC §103(a) for allegedly being unpatentable over WO 98/48858 (WO '858) in view of JP 07-070545 (JP '545) and GB 1431683 ('683). Reconsideration is requested.

In the context of a rejection for obviousness under §103, the "Examiner bears [both] the initial burden...of presenting a *prima facie* case of unpatentability" and "the ultimate burden of persuasion on the issue," *In re Oetiker*, 24 USPQ2d 1443, 1444 and 1447 (Fed. Cir. 1992), and the "Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art *would lead* that individual to combine the relevant references....Indeed, the teachings of the references can be combined only if there is some suggestion or incentive to do so." *Ex parte Obukowicz*, 27 USPQ2d 1063, 1065 (BPA&I 1992) (*emphasis, added*). Reliance on combining the teachings of WO '858 with JP '545 and GB '683 render the rejection fatally flawed.

As alleged in the rejection (Office Action, page 6),"it would have been obvious to . . . replace the [WO '858] block copolymer comprising styrene with [the] copolymer comprising [a] hydrophobic block and hydrophilic block as taught by JP '545 and further use [the] block copolymer having . . . hydrophilic end block polymer . . . as taught by GB '683." The aforesaid allegation

impermissibly ignores contradictory teachings in the cited references, themselves. The totality of each reference's teachings must be considered when combining those teachings with the rest of the prior art in a §103 analysis. *W. L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303, 311 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

It is impermissible within the framework of §103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.

In re Hedges, 228 USPQ 685, 687 (Fed. Cir. 1986).

The WO '858 invention block-copolymer component, which the rejection would "replace," must be "a physically cross-linked elastomer selected from block-copolymers comprising styrene and one or more butadienes" (WO'858, page 5, first complete paragraph, and claim 1). Since the rejection would "replace" the WO '858 block copolymer with one that does not contain "one or more butadienes" (i.e., the diblock (AB) amphiphilic copolymer of GB '683), it would effectively destroy the invention on which WO '858 is based and, therefore, the rejection is untenable. In an obviousness analysis, a reference can not be combined with another reference in such a way that destroys the invention on which one of the references is based. *Ex parte Hartmann*, 186 USPQ 366 (POBdApp 1974). *In re Ratti*, 123USPQ 349, 352 (CCPA 1959).

Looking at it another way, the references relied on in combination effectively teach away from being so combined. WO '658 teaches an adhesive composition invention, a component of which is an elastomer block copolymer comprising styrene and one or more butadienes. Since the cross-linked elastomer is a component of the WO '858 invention, the reference effectively teaches


away from replacing the invention component with something else (i.e., if something else were used, the composition would no longer constitute the WO '858 invention). Since WO '858 teaches away from replacing the invention component, on which replacement the rejection indispensably relies, the rejection cannot be maintained. *Tech Air, Inc., v. Denso Manufacturing Michigan Inc.*, 52 USPQ2d 1294, 1298 (Fed. Cir. 1999) ("There is no suggestion to combine . . . if a reference teaches away from its combination with another source"). When one of two cited references is found to "teach away from [the other], then that finding alone can defeat the obviousness claim." *Winner Int'l. Royalty Corp. v. Wang*, 53 USPQ2d 1580, 1587 (Fed. Cir. 2000), *cert. denied*, 530 U.S. 1238 (2000).

Still further, the rejection constitutes clear error because cited reference WO '858 teaches away from the presently claimed invention. That is, the WO '858 requirement for "a physically cross-linked elastomer selected from block-copolymers comprising styrene and one or more butadienes" (as above) would have led the skilled artisan away from the "one or more amphiphilic block-copolymers" component as used in the presently claimed invention. "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be . . . led in a direction divergent from the path that was taken by the applicant," *In re Gurley*, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994), and "an applicant may rebut a prima facie case of obviousness by showing that the prior art teaches away from the claimed invention in any material respect." *In re Peterson*, 65 USPQ2d 1379 (Fed. Cir. 2003).

In view of the foregoing remarks, the rejection of claims 1, 6-13, 21, 26, 37-42 under §103(a), as allegedly being unpatentable over WO '858, JP '545 and GB '683, is overcome.
Withdrawal of the rejection is in order.

Favorable action is requested.

Respectfully submitted,


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